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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/235,156      | 01/22/1999  | JOSHUA SUSSER        | 50253-219;P3        | 5106             |

7590 07/31/2002

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EXAMINER

BULLOCK JR, LEWIS ALEXANDER

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 2151     |              |

DATE MAILED: 07/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                   |                  |
|------------------------------|-----------------------------------|------------------|
| <b>Office Action Summary</b> | Application No.                   | Applicant(s)     |
|                              | 09/235,156                        | SUSSER ET AL.    |
|                              | Examiner<br>Lewis A. Bullock, Jr. | Art Unit<br>2151 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1 and 23-42 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1 and 23-42 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 4, 7, 12-15
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

1. New formal drawings are required in this application because of Draftperson's Review. Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

2. Claims 27-31 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant states that the context barrier enforces security checks on at least one principle, object, and an action. It is unclear on the interpretation of this claim since claim 1 (parent claim) details the monitoring of communication between program modules. It is further examined that the program module is a principle or object. Applicant is requested to clarify if the examiner is correct in his assumption and amend the claims as such.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 23-34, 36-42 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 30-48 and of copending Application No. 09/235,157. Although the conflicting claims are not identical, they are not patentably distinct from each other because a global data structure can be an entry point object and vice versa as defined.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claim 35 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 41 of copending Application No. 09/235,157. Although the conflicting claims are not identical, they are not patentably distinct from each other because when both program modules have access to the same structure it would be obvious when passing information that one program module would write information and the other would read information.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1, 36, 38, and 41 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 18,

20, and 23 of copending Application No. 09/235,158 in view of "Infrastructure of Multi-Application Smart Card" by CHAN. As to claims 1, 18, 20, and 23, Application 09/235,158 substantially disclose the limitations. However, Application 09/235,158 does not teach a global data structure as disclosed. CHAN teaches a global data structure for permitting one program module to access information from another program module (via shared common security module / unique identification module) (pg. 4-10, figure 7, figure 10).

This is a provisional obviousness-type double patenting rejection.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1 and 32-42 are rejected under 35 U.S.C. 102(b) as being anticipated by "Java Card 2.0 Programming Concepts" by SUN.

As to claims 1, 32, and 34-42, SUN teaches a small footprint device (card) comprising: processing element; memory; context barrier (firewall) for isolating program modules from one another (applets); and a global data structure (virtual machine / JCER) for permitting one program module to access information from another program module across the context barrier (pg. 7 – 8, Applet Isolation and Object Sharing).

As to claim 33, SUN teaches the context barrier will not permit a principle to perform an action on an object unless they are part of the same context (pg. 3, section 2.3, "The owning applet always has full privileges to use and modify the object.").

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 23-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Java Card 2.0 Programming Concepts" by SUN.

As to claims 23, 25, and 27-31, SUN teaches isolating program modules by using a firewall. It would be obvious that each applications has separate memory / namespaces since the applications are separated by the firewall.

As to claims 24 and 26, SUN teaches the program modules can access the global data structure (applet register) (pg. 4).

11. Claims 1, 23-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Infrastructure of Multi-Application Smart Card" by CHAN in view of "Designers offered first 16-bit smart card IC architecture with development tools" by PHILIPS.

As to claims 1, 32, and 34-42, CHAN teaches a small footprint device (multi-application smart card) comprising: at least one processing element; memory (pg. 1, introduction); and a global data structure (shared common security module / unique identification module) for permitting one program module to access information from another program module (applications / biometric module) (pg. 4-10, figure 7, figure 10). However, CHAN does not explicitly mention a context barrier.

PHILIPS teaches a smart card having a context barrier for isolating program modules from one another (pg. 1, "Based on a unique smart card hardware firewall which isolates different applications from each other, SmartXA ensures secure and safe handling of several applications from different service providers on a single card."). Chan teaches the applications communicate with each other through a security module / identification module and therefore it would be obvious that the addition of Philips to Chan would allow one to communicate across the firewall. Therefore, it would be obvious to combine the teachings of CHAN with the teachings of PHILIPS in order to facilitate security and reliability of the card program (pg.1).

As to claims 23, 25, and 27-31, PHILIPS teaches the firewall separates each program module (pg. 1). It would be obvious that each applications has separate memory / namespaces since the applications are separated by the firewall.

As to claims 24, and 26, CHAN teaches each program module has access to the global data structure (shared common security module / unique identification module) (pg. 4-10, figure 7, figure 10).

As to claim 33, It is well known in the art that a firewall allows communicate between programs within the same memory space or context.

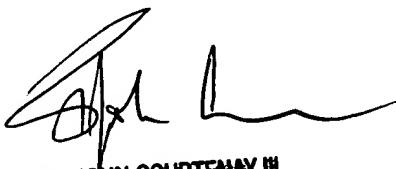
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lewis A. Bullock, Jr. whose telephone number is (703) 305-0439. The examiner can normally be reached on Monday-Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alvin E. Oberley can be reached on (703) 305-9716. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-0286.

lab  
July 25, 2002



ST. JOHN COURTEMAY III  
PRIMARY EXAMINER